

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 019281-001610US									
I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office on October 10, 2008. Signature <u>/Sherry Soares/</u> Typed or printed name <u>Sherry Soares</u>	Application Number 09/877,317		Filed June 8, 2001								
	First Named Inventor John J. Sie, et al.										
	Art Unit 2143	Examiner Alina A. Boutah									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top;"><u>/William J. Daley/</u> Signature</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top;"><u>William J. Daley</u> Typed or printed name</td></tr><tr><td style="vertical-align: top;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,471</u></td><td style="vertical-align: top;"><u>(303) 571-4000</u> Telephone number</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top;"><u>October 10, 2008</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	<u>/William J. Daley/</u> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>William J. Daley</u> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,471</u>	<u>(303) 571-4000</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>October 10, 2008</u> Date
<input type="checkbox"/> applicant/inventor.	<u>/William J. Daley/</u> Signature										
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<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,471</u>	<u>(303) 571-4000</u> Telephone number										
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<input type="checkbox"/> *Total of _____ forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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on October 10, 2008.

**STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

TOWNSEND and TOWNSEND and CREW LLP

By: /Sherry Soares/
Sherry Soares

PATENT
Attorney Docket No.: 019281-001610US

AIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John J. Sie, et al.

Application No.: 09/877,317

Filed: June 8, 2001

For: PRE-STORING MULTIPLE
PROGRAMS WITH USER CONTROL
OF PLAYBACK

Customer No.: 20350

Confirmation No.: 9420

Examiner: Alina A. Boutah

Art Unit: 2143

**STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

***Via EFS-Web
Mail Stop AF***
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This statement is submitted in support of the Pre-Appeal Brief Request for Review, that is submitted herewith. The applicants respectfully request review of the final rejection mailed by the U.S. Patent Office for the above-identified application on July 10, 2008 (“the Final Office Action”).

A Notice of Appeal is being filed concurrently herewith.

1. Status of Claims

Claims 9-15 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; and claims 9-15 and 19-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 5,729,280 to Inoue et al. (hereinafter "Inoue").

2. Reasons for Requesting Review

The final Office Action has rejected claims 9-15 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. More specifically, the final Office Action alleges that "the specification does not disclose 'wherein determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs' as amended." The Applicants respectfully submit that support for these recitations can be found throughout the specification including but not limited to Fig. 21 and 22 and the accompanying description on pages 32-34 of the description. Therefore, the Applicants respectfully request withdrawal of the rejection.

The Final Office Action has rejected claims 9-15 and 19-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,280 to Inoue et al. (hereinafter "Inoue"). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Specifically, the reference cited by the final Office Action does not teach or suggest each claimed limitation. For example, Inoue does not teach or suggest recording all first segments of a plurality of programs sent from a content provider before a user request for a program. Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims.

Inoue "relates to a video signal receiver for a near video-on-demand broadcast system." (Column 1, lines 7-8) In one embodiment of Inoue, "the near video-on-demand signal receiver pre-stores the first segment of a desired video program in the buffer memory apparatus." (Column 8, lines 35-38) "When a user requests reception and display of the video program, the

pre-recorded segment is immediately reproduced and displayed while the receiver scans the channels carrying the program for the remaining segment of the program.” (Column 8, lines 38-42) “Once a transmission of the remaining segment is found, the corresponding video signals are received, stored, reproduced, and displayed.” (Column 8, lines 42-44)

That is, Inoue teaches storing a portion of a requested program that can be played out while remaining portions of the program are located and received. As noted in Inoue, "by storing a portion of a selected video program, the receiver can display the stored portion of the program while awaiting or receiving transmission from the broadcaster of a subsequent portion of the program." (Col.3, lines 60-63) However, Inoue does not teach or suggest storing a first segment of each of a plurality of programs. In other words, Inoue does not teach or suggest storing the first segment of all of a plurality of programs. Rather, Inoue teaches storing a program that is selected in some way such as identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (See e.g., Col. 8, lines 49-57) Thus, only selected programs are stored, not a first segment of all programs.

In response to these arguments, the final Office Action notes that "Inoue teaches recording a first segment of a plurality of programs sent from the content provider, but not necessarily all of the programs" and argues that "one of ordinary skill in the art would recognize that this is an obvious variation of the teaching of Inoue." However, the Applicants respectfully reiterate that Inoue does not teach or suggest recording all or any first portion before a program is selected or requested by the user as discussed in detail above. Rather, Inoue teaches storing a program that is selected in some way such as identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. For at least these reasons the Applicants respectfully contend that the rejection is improper and should be withdrawn.

Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims. Rather, Inoue disclose only sending an entire program on any given channel. For example, see

figures 2A through 4B and the accompanying description of Inoue in which is described a program being played out in its entirety on any given channel. Upon selection of one of the programs, a first portion, e.g., a first seventeen minutes, or the program is recorded. However, this first seventeen minutes is not sent from the content provider as a first segment. Rather, it is sent as apart of the broadcast of the entirety of the program. So, for example, Inoue cannot implement a method "wherein the first digital channel does not send the second segment" as recited in new claim 28 or wherein the first segment is sent only once as recited in new claim 29. Also, Inoue cannot implement a method "wherein the first segment is sent via a first delivery mechanism and the second segment is sent via a second delivery mechanism" as recited in new claim 31 or "wherein the first delivery mechanism comprises a cable television network and the second delivery mechanism comprises a broadband network connection" as recited in new claims 32.

Claim 9, upon which claims 10-15, 22-24, and 28-32 depend, recites in part "determining if any of a first segment of each of a plurality of programs sent from the content provider are not already stored; [and] recording any first segment of each of the plurality of programs that are not already stored, wherein determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs." However, Inoue does not teach or suggest determining if any of a first segment of each of a plurality of programs sent from the content provider and recording any first segment of each of the plurality of programs that are not already stored before any user request for any of the plurality of programs are not already stored, i.e., recording all first segments. Rather, Inoue teaches pre-recording only portions of a selected programs based on identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (Column 8, lines 47-57.) Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims. Rather, Inoue disclose only sending an entire program on any

given channel. For at least these reasons, the rejection should be withdrawn and claims 9-15, 22-24, and 28-32 should be allowed.

Claim 19, upon which claims 20, 21, and 25-27 depend, recites in part “recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program.” However, Inoue does not teach or suggest recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program. Rather, pre-recording only portions of a selected programs based on identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (Column 8, lines 47-57.) Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims. Rather, Inoue disclose only sending an entire program on any given channel. For at least these reasons, the Applicants maintain that the rejection is improper and should be withdrawn.

Respectfully submitted,

Date: October 10, 2008

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